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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,188	02/05/2004	Jason E. Tripard	MI22-2494	7195
21567	7590	10/30/2006	EXAMINER	
WELLS ST. JOHN P.S. 601 W. FIRST AVENUE, SUITE 1300 SPOKANE, WA 99201				KALAM, ABUL
			ART UNIT	PAPER NUMBER
			2814	

DATE MAILED: 10/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/774,188	TRIPARD, JASON E.
	Examiner	Art Unit
	Abul Kalam	2814

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 14 August 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-10 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,4-6 and 8 is/are rejected.
- 7) Claim(s) 2,3,7,9 and 10 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 05 February 2004 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/14/06</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

Claim Status

In the amendments, filed on August 14, 2006, claims 1 and 5 were amended and claims 1-10 remain pending in the application.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969). A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. **Claims 1, 4-6 and 8 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 24 of U.S. Patent No. 6,277,671.**

Although the conflicting claims are not identical, they are not patentably distinct from each other because independent claims 1 and 8 and dependent claims 4-6, of the current application, contain all the limitations of claim 24 of the patent.

With respect to **claim 1 of the application**, claim 24 of the patent has the following limitations:

A method for forming (separating) integrated circuit packages from a board having a plurality of integrated circuits, comprising:
providing a base having a plurality of pins extending upwardly therefrom;

providing a support over the base, the support having an upper planar surface and a pair of opposing ends, the support having a plurality of holes extending therethrough, the pins extending through the holes and upwardly beyond the upper planar surface of the support;

placing the board over the support upper planar surface, the pins extending into the holes in the board (configuring the support and base);

vertically displacing the support by pneumatically powered actuators to lift the support off the pins, the vertically displacing comprising lifting both ends of the support substantially simultaneously and substantially in unison;

while the board is over the support upper planar surface, cutting the board to separate the integrated circuit packages from one another;

Thus, the claim 24 of the patent has all the limitations of claim 1 of the application with the exception of explicitly claiming: providing each actuator of the pair with release valves to equilibrate a back-pressure to ambient during lifting of the support;

However, it would have been obvious to one of ordinary skill in the art at the time of the invention to have the outline lines comprises of release valves because the function limitation, "maintaining a substantially equal gas pressure comprises equilibrating gas in the outlet lines with ambient pressure during the lifting," would not be possible without the release valves.

With respect to **claim 4 of the application**, claim 24 of the patent has the limitations set forth in claim 1 above, including wherein the vertically displacing the support comprises forcing gas into the actuators.

With respect to **claim 5 of the application**, claim 24 of the patent has the limitations set forth in claim 1 and 5 above, including wherein the substantially simultaneously and substantially in unison lifting of the ends of the support comprising forcing the gas into the individual actuators substantially simultaneously, and maintaining a substantially equal gas pressure at both actuators during the lifting.

With respect to **claim 6 of the application**, claim 24 of the patent has the limitations set forth in claim 1 above, including wherein the maintaining a substantially equal gas pressure comprises equilibrating gas, through outlet lines of the individual actuators with ambient during the lifting.

With respect to **claim 8 of the application**, claim 24 of the patent has the following limitations:

A method for forming (separating) integrated circuit packages from a board having a plurality of integrated circuits, comprising:
providing a base having a plurality of pins extending upwardly therefrom;
providing a support over the base, the support having a plurality of holes extending there-through, the pins extending through the holes;
vertically displacing the support by pneumatically powered actuators to lift the support off the pins, the vertically displacing comprising lifting both ends of the support substantially simultaneously and substantially in unison;
while the board is over the support upper planar surface, cutting the board to separate the integrated circuit packages from one another;

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Thus, the claim 24 of the patent has all the limitations of claim 8 of the application with the exception of explicitly claiming: providing each actuator of the pair with release valves to equilibrate a back-pressure to ambient during lifting of the support;

However, it would have been obvious to one of ordinary skill in the art at the time of the invention to have the outline lines comprises of release valves because the function limitation, "maintaining a substantially equal gas pressure comprises equilibrating gas in the outlet lines with ambient pressure during the lifting," would not be possible without the release valves.

Response to Arguments

2. Applicant's arguments (see pages 7-8 of Applicants Response), filed on August 14, 2006, with respect to the nonstatutory obviousness-type double patenting rejection of claims 1, 4-6 and 8, have been fully considered but are not persuasive. Applicant argues that an "obviousness-type double patenting rejection should make clear...(B) The reason why a person of ordinary skill in the art would conclude that the invention defined in the at issue would have been an obvious variation of the invention defined in a claim in the patent." Thus, in the obviousness-type double patenting rejection above, the Office has clarified and further explained the reasons for the obviousness-type double patenting rejection. Specifically, that outline lines must comprise of release valves because the function limitation, "maintaining a substantially equal gas pressure comprises equilibrating gas in the outlet lines with ambient pressure during the lifting," would not be possible without the release valves. Furthermore, references **Beselt (US**

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63,56,811) and Barringer et al. (US 6,034,524) are cited here to illustrate that release valves are an obvious feature of pneumatic actuators (**Beselt: col.1, Ins. 53-56**) (**Barringer: col. 6, Ins. 35-43; col. 7: Ins. 29-35**).

Applicant's arguments (see pages 8-11 of Applicants Response), filed on August 14, 2006, with respect to the 35 U.S.C. 103(a) rejection of claims 1-3 and 7-10, have been fully considered and are persuasive, because the applicant is correct in stating that Lodewegen does not teach the limitation, "vertically displacing the support off the pins using a pair of pneumatic actuators such that individual actuators of the pair lift respective opposing ends of the support substantially simultaneously and in unison," is not taught by. Therefore the 35 U.S.C. 103(a) rejection of claims 1-3 and 7-10 has been withdrawn.

Allowable Subject Matter

3. **Claims 2, 3, 7, 9 and 10** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

With respect to **claim 2**, the prior art of record neither anticipates nor renders obvious all the limitations of the claim, including: wherein the method further comprises aligning the pins and the board such that each of the separated integrated circuit packages is retained to the support by at least one pin, the vertically displacing the including releasing the separated integrated circuit packages from the pins.

With respect to **claim 3**, the prior art of record neither anticipates nor renders obvious all the limitations of the claim, including: wherein the method further comprises aligning the pins and the board such that each of the separated integrated circuit packages is retained to the support by at least two pins, the vertically displacing releasing the separated integrated circuit packages from the pins.

With respect to **claim 7**, the prior art of record neither anticipates nor renders obvious all the limitations of the claim, including: wherein the vertically displacing comprises selectively flowing fluid from an external source into one or more ports of each actuator to selectively control displacement of the respective opposing ends of the support.

With respect to **claim 9**, the prior art of record neither anticipates nor renders obvious all the limitations of the claim, including: wherein the method further comprises aligning the pins and the board such that each of the separated integrated circuit packages is retained to the support by at least one pin, the vertically displacing the including releasing the separated integrated circuit packages from the pins.

With respect to **claim 10**, the prior art of record neither anticipates nor renders obvious all the limitations of the claim, including: wherein the method further comprises aligning the pins and the board such that each of the separated integrated circuit packages is retained to the support by at least two pins, the vertically displacing releasing the separated integrated circuit packages from the pins.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abul Kalam whose telephone number is 571-272-8346. The examiner can normally be reached on Monday - Friday, 9 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wael M. Fahmy can be reached on 571-272-1705. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Abul Kalam



THAO X. LE
PRIMARY PATENT EXAMINER

10/25/06.